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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/678,516	10/03/2000	Randy Gray Simmons	17499	5361

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EXAMINER

GUSHI, ROSS N

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 10/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/678,516

Applicant(s)

SIMMONS ET AL.

Examiner

Ross N. Gushi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-25 is/are rejected.
- 7) ☐ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

Regarding the amendment to claim 1, the examiner notes that the clean copy of the claim 1 still includes the limitation that the receptacle is for receiving an RJ-standard compliant mating plug, however the limitation is in brackets making it confusing and unclear whether the limitation is intended to be in the claim or deleted. The limitation is treated as being deleted as indicated in the remarks. Applicant's response to this Office action should include a correct clean copy of the amended claims.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 13, 24, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinoshita et al. ("Kinoshita"). Kinoshita discloses a modular jack connector assembly comprising a dielectric housing (11) having a front and rear orientation and defining at least one receptacle adapted for receiving a mating plug; and a plurality of contacts (12) disposed in said housing, each contact being secured to a rear portion of said housing (e.g. at 12a or 12e), each contact extending forward (see attachment) into said receptacle from said rear portion to a free end 12b such that a portion of said contact forward of said rear portion electrically connects with a mating plug when the mating plug is received within said receptacle, said housing has a rear

side defining a slot (16) suitable for receiving an edge of a circuit board 15, and wherein a connection portion 12c of each contact extends from said rear portion of said housing into said slot such that when said housing is mounted to a circuit board a portion of said connection portion makes contact with the circuit board.

Per claim 13, the Kinoshita housing comprises one receptacle.

Per claim 24, each contact consists of the free end connected to an upwardly angled section contacted to an elongated arm which is connected to the connection portion (see attachment).

Per claim 25, the connection portion is curved around the rear portion to anchor the contact in the housing.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 4 – 12, and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita et al. ("Kinoshita") as in claim 1.
2. Kinoshita discloses a modular jack connector assembly comprising a dielectric housing (11) having a front and rear orientation and defining at least one receptacle adapted for receiving a mating plug; and a plurality of contacts (12) disposed in said housing, each contact being secured to a rear portion of said housing (e.g. at 12a or 12e), each contact extending forward into the receptacle from said rear portion to a free

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end 12b such that a portion of said contact forward of said rear portion electrically connects with a mating plug when the mating plug is received within said receptacle, said housing has a rear side defining a slot (16) suitable for receiving an edge of a circuit board 15, and wherein a connection portion 12c of each contact extends from said rear portion of said housing into said slot such that when said housing is mounted to a circuit board a portion of said connection portion makes contact with the circuit board. To the extent that Kinoshita is not explicit in stating that the mating plugs are "RJ standard compliant," at the time of the invention, it would have been obvious to have the connector be mateable with "RG standard compliant" plugs. The suggestion or motivation for doing so would have been to allow the connector to be used with standardized parts, as suggested in Kinoshita, col. 1, lines 10-15, and as is well known in the art.

3. Regarding claims 5, 6, 7, 11, 12, 16, 17, 18, 19, 20, and 23, regarding the relative dimensions, strengths, and proportions of the contact, it is impossible to tell whether the Kinoshita contacts meet the claimed limitations or not, especially given that the referenced "RJ-standards" were not even in existence at the time the Kinoshita patent was published. However, at the time of the invention, it would have been obvious to one with ordinary skill in the art that the contact dimensions, strengths, or proportions could be varied as desired. The suggestion or motivation for doing so would have been for example to improve durability and to obtain desired compliance, such motivations being well known in the art. Furthermore, the claimed variations in relative sizes, proportions, or dimensions, of the contacts, where the claimed device

does not perform differently compared to the prior art device, do not patentably distinguish the claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

4. Regarding claims 21-23 and 8-10, to the extent that Kinoshita is not explicit in stating that the connector is configured to receive RJ-45 or RJ-11 standard plugs, at the time of the invention, it would have been obvious to construct the Kinoshita device so as to receive standard plugs. The suggestion or motivation for doing so would have been to allow the connector to be used with standardized parts, as suggested in Kinoshita, col. 1, lines 10-15, and as is well known in the art.

5. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kinoshita as in claim 1 in view of Laity '962. Kinoshita discloses a single receptacle housing, not a housing with two or more receptacles. Laity discloses a connector including a plurality of RJ-type receptacles. At the time of the invention, it would have been obvious to modify the Kinoshita connector to accommodate a plurality of RJ-type receptacles, as taught in Laity. The suggestion or motivation for doing so would have been to allow electrical connection to the circuit board via a variety of plugs or to connect the board to a variety of devices, as taught in Laity.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Laity '962 in view of Kinoshita as in claim 1. Laity discloses a PCMCIA card comprising a card housing, a circuit board mounted in the card housing, and a modular jack connector comprising a housing and contacts. Arguably the Laity contacts are not secured at a rear portion of the housing. At the time of the invention, it would have

been obvious to use the Kinoshita connector in the Laity card. The suggestion or motivation for doing so would have been to reduce the space required for the assembly as taught in Kinoshita (col. 1, lines 34-41).

### ***Response to Arguments***

Applicant's arguments filed 9/3/2 have been fully considered but they are not persuasive. Applicant argues that the Kinoshita contacts do not extend forward into the receptacle from the rear portion . . . . The examiner disagrees. See the attachment in particular. The Kinoshita contacts extend forward into the receptacle as claimed. Applicant argues that the Kinoshita contact wraps around the housing and extends into the receptacle from front to back. The examiner agrees with this description. This structure, both the straight upper horizontal portion and the angled portion extending into the receptacle considered together, reads on a contact "extending forward into said receptacle from the rear portion.

Applicant argues that there is no motivation to modify Kinoshita. Regarding claim 1, no modification is suggested by the examiner.

Applicant argues that whether a device is intended to cooperate with a device of a particular standard, but itself does not comply with the standard is critical. The examiner disagrees. The relevant case law indicates that variations in the relative sizes, proportions, or dimensions of the contacts, where the claimed device does not perform differently compared to the prior art device do not patentably distinguish the

claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984).

Applicant argues that it would not have been obvious to vary dimensions of the contact such the contact deviates from a standard contact. Again, the relevant case law indicates that variations in the relative sizes, proportions, or dimensions, of the contacts where the claimed device does not perform differently compared to the prior art device do not patentably distinguish the claimed invention from the prior art. Gardner v. TEC Systems, Inc., 725 F.2d 1338 (Ct. App. Fed Cir. 1984). The caselaw does not distinguish variations that conform to particular standards from variations that deviate from particular standards.

#### ***Allowable Subject Matter***

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art does not suggest the assembly as claimed, including the combination of all the claimed elements, the combination including the particular orientations of the angled portion and the arm portion as claimed.

#### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ross Gushi whose telephone number is (703) 306-4508. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Paula A. Bradley, can be reached at (703) 308-2319. The phone number for the Group's facsimile is (703) 308-7722

rng

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